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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Angelo T. DONFRANCESCO et al.

Serial No.: 09/105,150

Filed: June 26, 1998

For: TERMINAL SYSTEM WITH
DEFORMED SCREW

PATENT

Appeal No.: _____

Group Art Unit: 2833

Examiner: F. Figueroa

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REPLY BRIEF

Commissioner for Patents
Washington, D.C. 20231

Sir:

Pursuant to 37 C.F.R. § 1.193(b), Applicants-Appellants submit this reply brief in response to the Examiner's Answer dated May 3, 2002 in connection with the appeal of the above-identified application. The following addresses the new points of argument raised in the Examiner's Answer.

Claims Stand or Fall Separately

On page 2, section (7) of the Examiner's Answer, the Examiner states for the first time that the claims stand or fall as a group since the claims have been rejected as a group under a similar basis and therefore should be treated as a group. Additionally, the Examiner's Answer alleges that the Applicants-Appellants have not provided reasons as set forth in 37 CFR §1.192(c)(7) and (c)(8). Furthermore, the Examiner's Answer alleges that the Applicants-

Appellants presented similar and grouped arguments for all independent claims. However, since different arguments are presented for different claims, the pending claims require separate consideration. The rejection is not determinative.

Applicants-Appellants submit that this single group treatment of all of the pending claims is not correct. As noted in the Amendment filed September 24, 2001, Applicants-Appellants note that independent claim 16 recites that the stake is formed on the second end, along a line extending across the second end offset from and perpendicular to a longitudinal axis of the shank. This claims element is not recited in either independent claim 1 or 11. Applicants-Appellants submit that this additional patentable distinction further defines the stake over the prior art and the other existing independent claims.

Furthermore, as noted in the Section C of the Argument portion of the Supplemental Brief on Appeal, Applicants-Appellants recite features in the claims dependent upon independent claims 1, 11 and 16 that further distinguish each dependent claim from the prior art. Since the cited and applied prior patent lacks these features, such prior patent does not render these claims obvious, as suggested by the Examiner. Additionally, with respect to dependent claims 9 and 15, page 11, second full paragraph of the Supplement Brief on Appeal, specifically states that the Crowther wire 34 is not a contact as claimed in the present invention, but rather a wire that is frictionally held between the base 12 and the clamp 14.

Therefore, Applicants-Appellants submit that the claims stand and fall separately and arguments to that effect have been presented in the prosecution of the application, including the Supplemental Appeal Brief, as noted above.

Reference to Crowther Patent Figure 5 Is Incorrect

On page 3, in the first paragraph of the Response to Arguments, the Examiner states for the first time that Figure 5 of the Crowther patent shows a deformation. However, Applicants-Appellants note that there is no Figure 5 in the Crowther patent, and therefore, Applicants-Appellants submit that this portion of the Examiner's Answer should be disregarded.

Crowther Does Not Anticipate or Render Obvious Deformation Along Chord in Planar End

In the first paragraph on page 3, the Examiner states for the first time that the Crowther patent shows a deformation extending in the circular, substantially planar end which is transverse to the longitudinal axis of the screw. In the previous Office Action, dated November 20, 2001, the Examiner stated that the deformation (36) is formed in a portion of the external thread adjacent the second end. Clearly, the Crowther patent does not show a deformation extending in the circular, substantially planar end which is transverse to the longitudinal axis of the screw since a plan view of that end is not illustrated.

Applicants-Appellants submit that the Crowther patent does not disclose, show or suggest a deformation extending in the circular, substantially planar end, which end is transverse to the longitudinal axis of the screw. At best, the Crowther patent discloses that "the last thread at the free extremity of screw 16 can be distorted as indicated at 36 by peening the end of the screw or by other suitable means." *See* Col. 2, lines 27-30.

In Fig. 2 the screw is shown in a side elevational view and the reference numeral 36 merely indicates the bottom portion of the screw. There is no disclosure or suggestion as to whether the peen occurs along the side of the screw parallel to the longitudinal axis of the screw shank, as is generally common in the prior art, or if the peen occurs along the circular,

substantially planar end, which is transverse to the longitudinal axis of the screw, as is suggested only by the Examiner. Therefore, the Crowther patent clearly does not anticipate or render obvious a deformation extending in the circular, substantially planar end transverse to the longitudinal axis of the screw.

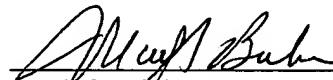
On page 4, the first full paragraph, the Examiner states for the first time that any deformation made on the second end of a shank “will extend along a chord” of the second end. Applicants-Appellants submit that this statement regarding the Crowther deformation is incorrect. The Crowther patent merely states that the last thread of the screw is distorted by peening or other suitable means. As noted above, this type of distortion can result in a distortion parallel to the longitudinal axis at the end of the screw shank or a distortion of just about any type on the circular, substantially planar end. If the distortion is on the circular, substantially planar end, as suggest by the Examiner, the distortion can be a point or a line that does not extend along a chord, but merely a distortion on one side of the threads, which extends partially inwardly from the outer edge of the circular, substantially planar end. Using hindsight, the Examiner arrives at the conclusion that this vague disclosure in the Crowther patent corresponds to the specific claim limitation in question. That conclusion is erroneous, since as stated above the peening of the end of the screw does not necessarily mean forming a chord along the planar bottom of a screw.

On page 4, second full paragraph, the Examiner states for the first time that the fact that the Crowther patent “could be interpreted in different ways does not obviate the manner in which Crowther defines it.” Since the Crowther patent is unclear, no motivation is disclosed to make a stake extending along a chord of the planar end of the screw, any suggestion that it does so is merely improper hindsight.

On page 5, the fourth paragraph, the Examiner states for the first time that since arguments regarding certain advantages are not specifically mentioned in the original disclosure, they are moot and cannot be considered. However, the superiority over the prior art need not be discussed in the application; it is enough if the property or utility in which the advantage resides is disclosed. *In re Slocombe*, 510 F.2d 1398, 184 USPQ 740, 743 (C.C.P.A. 1975). Furthermore, the advantage of the stake being quicker and easier to form is disclosed in the specification. As noted on page 4, lines 3-6, of the specification of this application, a further object of the present invention is to provide a terminal assembly which is easy to manufacture and provides a terminal assembly which is inexpensive. As noted in lines 24-25 of that same page, the stake forms the deformation and can be easily formed. Since the advantages in issue are disclosed in the specification and are the basic properties, such should be considered.

On page 6, third full paragraph, the Examiner states that the fact that the specification discloses that the terminal assembly is “easy to manufacture” and that the stake can be “easily formed”, does not support the argument that “the stake is quicker and easier to form”. If a device is “easy to manufacture” or “easily formed”, inherently, as would be readily recognized by those skilled in the pertinent art, such device is “easy to manufacture” or “easier to manufacture” compared to similar types of devices in the art. As noted above, there is no requirement that the superiority over the prior art be discussed in the application; it is enough if the property or utility in which the advantage resides is disclosed. *In re Slocombe*, 184 USPQ at 743.

For the reasons discussed above and presented in Applicants-Appellants' Brief on Appeal and Supplement Brief on Appeal, claims 1, 4-16 and 18 are not obvious over the Crowther patent. Reversal of the final rejection is requested.



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